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Attorney's Docket No. 004900-169Application No. 09/386,850

Page 6

**REMARKS**

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, the first page of the specification has been amended to update the status of the continuing data with respect to a now issued patent, to correct the priority filing date of the first parent application,<sup>1</sup> and to correct certain grammatical issues. Pages 2 and 11 of the specification have also been amended to insert the assigned sequence identifiers at appropriate locations.<sup>2</sup> Additionally, claims 15 and 16 have been amended. Claim 16 has been amended to recite the hybridization conditions. Support for this amendment can be found on page 8, lines 20-27, of the specification. Claim 17 has been amended to recite that the RNAs is transferred to a "nitrocellulose" membrane.

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<sup>1</sup> As described *infra*, the priority filing date is the date of the international application filing date and not the 35 U.S.C. § 102(e) date.

<sup>2</sup> With regard to the amendment to page 2 of the specification, it is noted that the assigned sequence identifier was inserted by the Amendment and Reply filed on March 20, 2003. However, the replacement paragraph inadvertently omitted a portion of the paragraph, thus leading to some confusion as to whether the sequence below (beginning on page 2, line 25 through page 3, line 13) was labeled. It is clear that this was an inadvertent omission since applicants did not affirmatively indicate by strike-out, or otherwise, that such language was to be omitted. Thus, by the present amendment, applicants have added the inadvertently omitted language back into the paragraph. In an abundance of caution with regard to the new amendment rules, applicants have underlined this re-inserted text even though it was technically not previously requested to be deleted. Thus, the sequence bridging pages 2 and 3 has been identified by its assigned sequence identifier.

Attorney's Docket No. 004900-169  
Application No. 09/386,850  
Page 7

Support for this amendment can be found on page 8, lines 18-20. Thus, no new matter has been added by the present amendment.

**I. FORMAL MATTERS**

**A. Priority Data**

As noted on the first page of the specification, the present application is a divisional of application Serial No. 08/476,120, filed on June 7, 1995, now United States Patent No. 6,025,143, which is a continuation of application Serial No. 08/153,277, filed on November 17, 1993, now United States Patent No. 5,859,189, which is a continuation of application Serial No. 07/499,276, now abandoned. United States application Serial No. 07/499,276 was filed as a national stage application under 35 U.S.C. § 371 of International Application No. PCT/FR89/00523, filed on October 11, 1989. *See* Exhibit A (copy of Form PCT/DO/EO/903 notifying applicants that Serial No. 07/499,276 satisfied the requirements of 35 U.S.C. § 371 and 37 C.F.R. § 1.494 and identifying the foreign priority claim); *see also* Exhibit B (copy of Form PCT/DO/EO/1390 which originally provided applicants indication that Serial No. 07/499,276 was a national stage filing under 35 U.S.C. § 371). Thus, the proper filing date for priority purposes for Serial No. 07/499,276 is the October 11, 1989 filing date of International Application No. PCT/FR89/00523, and not the 35 U.S.C. § 102(e) date. *See* Exhibit A. International Application No. PCT/FR89/00523 claims priority to French application No. 88 13353, filed on October 11, 1988.

Attorney's Docket No. 004900-169  
Application No. 09/386,850  
Page 8

The present application has claimed priority to all of these United States, International and French priority applications. Contrary to the Examiner's suggestion, reference to International Application No. PCT/FR89/00523 is not required to be recited in the first paragraph of the specification. While section 202.01 of the M.P.E.P. states that the first sentence of the specification must include reference to those applications which benefit is sought under 35 U.S.C. § 120 of § 121, section 1893.03(c) of the M.P.E.P. states that "it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number . . . ." *See* M.P.E.P. § 1893.03(c) at 1800-156.

It is further noted that the "claim for priority" to International Application No. PCT/FR89/00523 in either of applicants' transmittal form or original Declaration and Power of Attorney (a copy of which was submitted at the time this application was filed) is technically meaningless. This is because, as described in section 1893.03(c) of the M.P.E.P., "a national stage application submitted under 35 U.S.C. § 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application." *See* M.P.E.P. § 1893.03(c) at 1800-156. Thus, to clarify the record, applicants have filed herewith a Supplemental Application Data Sheet.

**B. Priority Document**

In this application the Examiner has not yet acknowledged receipt of the certified copy of the foreign priority document (French application No. 88 13353, filed on October

Attorney's Docket No. 004900-169  
Application No. 09/386,850  
Page 9

11, 1988). It is noted that acknowledgment of receipt of the certified copy was indicated by the United States Patent and Trademark Office in at least parent application Serial No. 07/499,276. See Exhibit C (copy of first page of Official Action in Serial No. 07/499,276). Therefore, in this case, the Examiner is hereby requested to acknowledge receipt of the certified foreign priority document for French application No. 88 13353, filed on October 11, 1988.

## **II. OBJECTION TO THE SPECIFICATION**

The Examiner has objected to the specification as allegedly not fully complying with the Sequences Rules. In particular, the Examiner has required the specification at page 2, line 25 to page 3, line 13 and page 11, lines 5, 12, 13, and 16-18 to include specific recitation of an assigned sequence identifier. As discussed above, the specification has been amended accordingly. Therefore, withdrawal of this objection is respectfully requested.

## **III. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

Claims 15 and 16 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which allegedly was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner has alleged that the terms "stringent" and "transferred to a nylon membrane" lack written description support. This rejection is respectfully traversed.

Attorney's Docket No. 004900-169Application No. 09/386,850

Page 10

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, claims 15 and 16 have been amended. Claim 16 has been amended to recite the hybridization conditions. Support for this amendment can be found on page 8, lines 20-27, of the specification. Claim 17 has been amended to recite that the RNAs is transferred to a "nitrocellulose" membrane. Support for this amendment can be found on page 8, lines 18-20.

In view of the above, withdrawal of this rejection is respectfully requested

### **III. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 15 and 16 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner has asserted that the terms "stringent" and "hybridize" are vague and indefinite. This rejection is respectfully traversed.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, claims 15 and 16 have been amended as described above.

Therefore, the Examiner is respectfully requested to withdraw this rejection.

Attorney's Docket No. 004900-169

Application No. 09/386,850

Page 11

#### **IV. REJECTION UNDER 35 U.S.C. § 102(b)**

Claims 15 and 16 have been rejected under 35 U.S.C. § 102(b), as purportedly anticipated by Rosinski-Chupin et al., PNAS, Vol. 85(22):8553-57 (November, 1988). This rejection is respectfully traversed.

As described in section I.A. above, applicants' claim for priority properly extends back to the October 11, 1988 filing date of French application No. 88 13353. This priority date precedes the date of the Rosinski-Chupin reference. Thus, Rosinski-Chupin is not available as prior art.

For at least this reason, applicants respectfully request the withdrawal of this rejection.

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

Attorney's Docket No. 004900-169Application No. 09/386,850

Page 12

In the event that there are any questions concerning this Amendment and Reply or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER &amp; MATHIS, L.L.P.

Date: December 17, 2003By: 

Susan M. Dadio

Registration No. 40,373

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

I hereby certify that this correspondence is being sent  
by Facsimile Transmission to the Assistant  
Commissioner For Patents, P.O. Box 1450,  
Alexandria, Virginia 22313-1450 on:

Date: 12-17-03Name: SUSAN M. DADIO

(Typed or printed name of person signing the certificate)

Sign: 

(Signature of person signing the certificate)

Date: 12/17/03

(Date of Signature)



# **EXHIBIT A**

.. / 499276

BURNS, DOANE, SWECKER & MATHIS GEORGE MASON BUILDING WASHINGTON & PRINCE STS. P.O. BOX 1404 ALEXANDRIA, VIRGINIA 22313-1404		UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495	
		Date of Mailing 13 August 1990	
		File Reference 004900-109	
IDENTIFICATION OF THE INTERNATIONAL APPLICATION			
International application Number PCTFR89/00523	International filing date 11 October 1989	Priority date claimed 11 October 1988	
Applicant for DO/EO/US CHUPIN, ISABELLE, et al.			
NOTIFICATION			
The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a <input checked="" type="checkbox"/> Designated Office, <input type="checkbox"/> Elected Office, has determined that the above identified international application has met the requirements of 35 U.S.C. 371 and 37 CFR <input checked="" type="checkbox"/> 1.494, <input type="checkbox"/> 1.495 and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.			
The United States Serial Number assigned to the application and the relevant dates are: <div style="display: flex; justify-content: space-around; align-items: center;"> <div style="text-align: center;"> <u>00499276</u>  <b>19 JUL 1990</b> </div> <div style="text-align: center;"> <b>19 JUL 1990</b> </div> </div>			
U.S. NATIONAL SERIAL NO. 35 U.S.C. 102(e) DATE DATE OF RECEIPT 35 U.S.C. 371 REQUIREMENTS			
<input checked="" type="checkbox"/> A request for immediate examination under 35 U.S.C. 371 (f) was received on <b>19 JUL 1990</b> and the application will be examined in turn.			
<input type="checkbox"/> No request for immediate examination under 35 U.S.C. 371(f) was received. The application will not be processed or examined before the time limit set forth in either			
<input checked="" type="checkbox"/> PCT Article 23 (Chapter I of the PCT), or <input type="checkbox"/> PCT Article 40 (Chapter II of the PCT) whichever is applicable.			
AUG 16 1990 RECEIVED SWECKER & MATHIS			
UNITED STATES DESIGNATED/ ELECTED OFFICE			
ADDRESS ONLY: COMMISSIONER OF PATENTS AND TRADEMARKS Box PCT, Attn. DO/EO/US Washington, D.C. 20231		AUTHORIZED OFFICER <i>Burns Doane</i>	

Form PCT/DO/EO/903 (U.S. Version) (April 1987)

U.S. DEPARTMENT OF COMMERCE - PTO

## **EXHIBIT B**

FORM PTO-1390  
(REV. 5-97)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTORNEY'S DOCKET NUMBER

**TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)**

004900-109

INTERNATIONAL APPLICATION NO.  
PCT/FR89/00523INTERNATIONAL FILING DATE  
11 October 1989PRIORITY DATE CLAIMED  
11 October 1988TITLE OF INVENTION PEPTIDES AND POLYPEPTIDES FROM THE SUB-MAXILARY GLAND OF THE RAT,  
CORRESPONDING MONOCLONAL AND POLYCLONAL ANTIBODIES, CORRESPONDING...PURPOSESAPPLICANT(S) FOR DO/EO/US  
Isabelle CHUPIN, Diana TRONIK, Francois ROUGEON and Nabii SEIDAH

Applicant herewith submits to the United States Designated/ Elected Office (DO/EO/US) the following items under 35 U.S.C. 371:

1. ☒ This express request to immediately begin national examination procedures (35 U.S.C. 371(f)).
2. ☒ The U.S. National Fee (35 U.S.C. 371(c)(1)) and other fees as follows:

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
TOTAL CLAIMS		37 -20-	17	X\$12.00	\$ 204.00
INDEPENDENT CLAIMS		8 -3-	5	X\$ 36. 00	180.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)				+\$ 120.00	120.00
BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(4)):					500.00
<input type="checkbox"/> International preliminary examination fee paid to USPTO (37 CFR 1.482)..... \$300					
<input type="checkbox"/> No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee paid to USPTO (37 CFR 1.445 (a)(2))..... \$340					
<input checked="" type="checkbox"/> Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO..... \$500.					
<input type="checkbox"/> International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(2) to (4)..... \$50					
Surcharge of \$ 120 for furnishing the National fee or oath or declaration later than <input checked="" type="checkbox"/> 20 <input type="checkbox"/> 30 mos. from the earliest claimed priority date (37 CFR 1.482(e)).					
				TOTAL OF ABOVE CALCULATIONS	= \$1,004.00
Reduction by 1/2 for filing by small entity, if applicable. Affidavit must be filed also. (Note 37 CFR 1.9, 1.27, 1.28.)					-0-
				SUBTOTAL	+ \$ 1,004.00
Processing fee of \$ 30 for furnishing the English Translation later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 mos. from the earliest claimed priority date (37 CFR 1.482(f)).					-0-
			TOTAL NATIONAL FEE	\$ 1,004.00	
Fee for recording the enclosed assignment (37 CFR 1.21(h)).				8.00	+ -0-
			TOTAL FEES ENCLOSED	\$ 1,004.00	

- a. ☒ A check in the amount of \$1,004.00 to cover the above fees is enclosed.
- b. ☐ Please charge my Deposit Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ to cover the above fees. A duplicate copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-4800. A duplicate copy of this sheet is enclosed.

ATTORNEY'S DOCKET NUMBER  
004900-109

3. A copy of the International Application as filed (35 U.S.C. 371(c)(2))
- ☒ is transmitted herewith (required only if not transmitted by the International Bureau).
  - ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
  - ☒ has been transmitted by the International Bureau.
4. ☒ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
5. Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
- ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
  - ☐ have been transmitted by the International Bureau.
6. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
7. ☐ An oath or declaration of the inventor (35 U.S.C. 371(c)(4)).
8. ☐ A translation of the Annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Other document(s) or information included:

- ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
- ☐ An assignment document for recording.

Please mail the recorded assignment document to:

- ☐ the person whose signature, name & address appears at the bottom of this page.
- ☐ the following:

11. The above checked items are being transmitted

- ☐ before the 18th month publication.
- ☒ after publication and the Article 20 communication but before 20 months from the priority date.
- ☐ after 20 months but before 22 months (surcharge and/or processing fee included).
- ☐ after 22 months (surcharge and/or processing fee included).

Note: Petition to revive (37 CFR 1.137(a) or (b)) is necessary if 35 U.S.C. 371 requirements submitted after 22 months and no proper demand for International Preliminary Examination was made by 19 months from the earliest claimed priority date.

- ☐ by 30 months and a proper demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
- ☐ after 30 months but before 32 months and a proper demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date (surcharge and/or processing fee included).
- ☐ after 32 months (surcharge and/or processing fee included).

Note: Petition to revive (37 CFR 1.137(a) or (b)) is necessary if 35 U.S.C. 371 requirements submitted after 32 months and a proper demand for International Preliminary Examination was made by 19 months from the earliest claimed priority date.

12. At the time of transmittal, the time limit for amending claims under Article 19

- ☒ has expired and no amendments were made.
- ☐ has not yet expired.

13. ☐ Certain requirements under 35 U.S.C. 371 were previously submitted by the applicant on \_\_\_\_\_, namely:

date

Regis E. Slutter  
NAME BURNS, DOANE, SWECKER & MATHIS  
George Mason Building  
ADDRESS Washington & Prince Streets  
P.O. Box 1404  
Alexandria, VA 22313-1404

SIGNATURE

26,999

REGISTRATION NUMBER

## **EXHIBIT C**


**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231

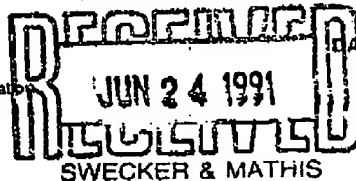
SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/499,276	07/19/90	ROSINSKI-CHUPIN	004900-109

MARSHALL EXAMINER

 BURNS, DOANE, SWECKER AND MATHIS  
 GEORGE MASON BLDG.  
 WASHINGTON AND PRINCE STREETS  
 P. O. BOX 1404  
 ALEXANDRIA, VA 22313-1404

ART UNIT	PAPER NUMBER
189	

BURNS, DOANE,



DATE MAILED: 06/20/91

 This is a communication from the examiner in charge of your application  
 COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☐ Claims 1-14 are pending in the application.  
 Of the above, claims 2, 4-13 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1, 3 and 14 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_